

REMARKS

The Final Office Action of September 9, 2008 has been carefully reviewed and the following amendments and remarks are made in response thereto. Claims 1-13 remain pending in the application. Claims 14-65 were previously withdrawn from consideration. Claims 1-13 stand rejected. Through this Response and Amendment, no claims have been amended. No new matter has been introduced into the application. As explained in more detail below, Applicants submit that all claims are in condition for allowance and respectfully request such action.

Claim Rejections – 35 USC § 103

Claims 1-2, 5, and 10-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Storek (US 2004/0259651) in view of Petrash (US 3,226,704). The Applicants respectfully request reconsideration in view of the Remarks below.

Applicants respectfully submit that the rejection is improper for at least two reasons. First, neither Storek nor Petrash, either individually or in combination, teach at least “a first accelerometer module removably mounted in a head of the golf club” as recited in independent claim 1 (or receiving golf swing data from an “accelerometer module removably mounted in a head of the golf club” as recited in independent claim 11). Second, the Office Action’s reliance on *In re Dulberg* is contrary to the M.P.E.P. and applicable case law.

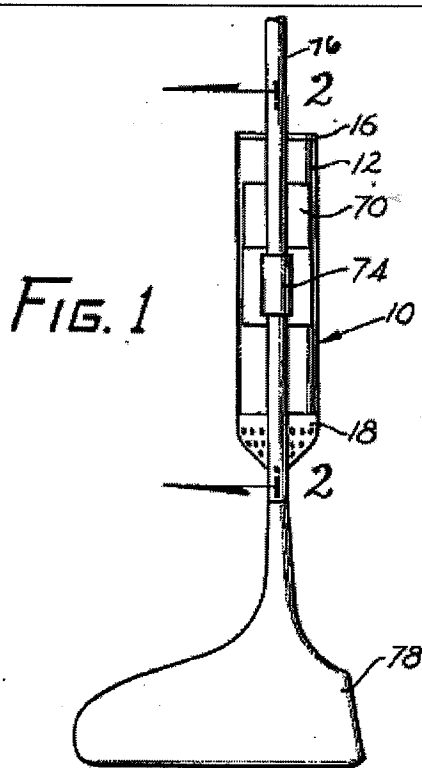
Regarding the first point, the Office Action admits Storek (the primary reference) does not teach this element. (*See, e.g.*, page 2, admitting that Storek “fails to teach the accelerometer is removable”). The secondary reference, Petrash, also does not teach, suggest, or disclose a removable accelerometer removably mounted in the head of the golf club. Rather, Petrash discloses a golf club that may comprise two accelerometers. In fact, Petrash explicitly recites an accelerometer within the club head, but never indicates that it may be removable, despite the fact that Petrash explicitly states that the accelerometer on the exterior of the shaft of the golf club may be removed from the exterior of the club. Indeed, as discussed in more detail below, the accelerometer of Petrash asserted to be “removable” is located externally on the shaft, and thus is not mounted in the club and could not be removably in the head of the golf head.

Indeed, providing a removable accelerometer in the head of the golf club has several advantages that are not disclosed, taught, or even suggested by the prior art of record, such as not

interfering with the aerodynamics of the club during the swing being measured, protecting against the environmental elements or damage every time a user places the club into a golf bag, and/or allowing a user to utilize another head/shaft combination without requiring the movement and alignment of the accelerometer each time. In fact, as further indicated by the Specification:

In one embodiment of the invention, all of the sensors are located within golf club 200 so as to not interfere with the aerodynamics of the club. Golf club 200 may also be configured so that the weights of the included components do not change the balance or center of gravity of the club. Golf club 200 may be a wood, iron, putter or specialty club.

(Specification, para. 30, lines 1-5, emphasis added). Thus, having a removable accelerometer within the club head is highly desirable and is drastically different than the art of record. Specifically, the Office Action cites element 10 of Figure 1 of Petrash as showing a detachable accelerometer.



As shown in Figure 1 of Petrash (reproduced to the left), Petrash's accelerometer is not *in* the head of the club. Rather, as recognized by the Office Action it is attached by *a clip* to the shaft of the golf club, thus suffering the disadvantages discussed above.

Further, there is no teaching, suggestion, or disclosure on how one skilled in the art could modify the clip holding the accelerometer to the outer perimeter of the shaft of Petrash *in* the head of the golf club of any other prior art reference. In fact, merely utilizing a clip is drastically different than removably placing an accelerometer *in* the head of the club, as evidenced by the many advantages discussed above, among others. Merely placing the external clipped accelerometer on the club head does not teach, suggest, or disclose the subject matter of the rejected claims.

In this regard, claim 2, which depends from claim 1 recites a golf club wherein "the weight of the first accelerometer and the second accelerometer do not change the balance or

center of gravity of the club.” Clearly, having an external accelerometer attached to the exterior of the shaft (as taught by Petrash) would alter the balance and center of gravity of the club. In response, the Office Action merely states "it would have been obvious to one of ordinary skilled in the art design the attachments of the accelerometers do not change the center of gravity of [sic] club." Applicants respectfully submit that these are merely conclusory statements without support.

The Examination Guidelines published by the PTO on October 10, 2007 make it clear that conclusory statements of the type used in the Final Office Action are not sufficient to support an obviousness rejection under 35 U.S.C. § 103. Specifically, when referencing KSR, the PTO noted:

The Court quoting *In re Kahn* stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

(72 Fed. Reg. 175 at 57528-57529; emphasis added). Therefore, each of the §103 rejections must at least demonstrate that each and every element recited in the rejected claims is disclosed in the prior art, and must provide some articulated reasoning with some rational underpinning to support the finding of obviousness. In this regard, Applicants respectfully submit that neither Storek, Petrash or any other art of record, whether applied individually or in combination, teach at least “a first accelerometer module removably mounted in a head of the golf club” or a golf club wherein “the weight of the first accelerometer and the second accelerometer do not change the balance or center of gravity of the club.”

Secondly, Applicants respectfully disagree with the Office Action’s reliance on *In re Dulberg*. Specifically, the Office Action cites *In re Dulberg* and alleges that "it is obvious to have elements of an apparatus separable." (Office action dated September 9 2008, page 3). First, as discussed above, merely having two separable components does not teach the subject matter of the rejected claims. Secondly, the Applicants respectfully disagree with the Examiner’s interpretation of *In re Dulberg*. Although M.P.E.P. §2144.04 (which sets forth the applicability of *In re Dulberg*) allows an Examiner to make an obviousness determination based only on

"sufficiently similar" caselaw, it also states that "[i]f the applicant has demonstrated the criticality of a specific limitation, it would *not be* appropriate to rely solely on case law as the rationale to support an obviousness rejection. (emphasis added). Indeed, as decided by the court in *For Your Ease Only v. Natural Science Industries Ltd.*:

because the removability limitation is critical to the [patent-at-issue], it would not be appropriate, under MPEP 2144.04, to rely solely on *Dulberg* for an obviousness rejection. Therefore, *Dulberg* alone does not raise a substantial question regarding the validity of the [patent-at-issue].

233 F.Supp.2d 988, 993 (N.D. Ill. 2002). Similarly, one of the differences between the subject matter of the rejected claims and the art at issue is the novelty of a removable accelerometer in the head of the golf club, and another difference is that "the weight of the first accelerometer and the second accelerometer do not change the balance or center of gravity of the club." In view of the foregoing, Applicants respectfully submit that the Office Action's reliance on *In re Dulberg* is incorrect and respectfully request the reconsideration and withdrawal of the rejection.

Claims 7-8 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Storek (US 2004/0259651) as applied to claims 1 and 11, and further in view of Gedney et al. (US 5,209,483). The Applicants respectfully request reconsideration in view of the Remarks below.

Claims 7-8 ultimately depend from claim 1 and claim 12 depends from claim 11. Applicants respectfully submit that the art of record does not teach, disclose, or suggest the subject matter of claims 1 and 11, and, therefore, submit that claims 7-8 and 12 are allowable over the art of record for at least the reasons discussed above in relation to claims 1 and 11. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 9 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Storek (US 2004/0259651) in view of Petrash and in view of Gedney et al. (US 5,209,483) as applied to claims 7 and 12, and further in view of McTeigue (US 5,221,088). The Applicants respectfully request reconsideration in view of the Remarks below.

Claim 9 ultimately depends from claim 1 and claim 13 ultimately depends from claim 11. Applicants respectfully submit that the art of record does not teach, disclose, or suggest the subject matter of claims 1 and 11, and, therefore, submit that claims 9 and 13 are allowable over the art of record for at least the reasons discussed above in relation to claims 1 and 11. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Storek (US 2004/0259651) in view of Petrash as applied to claim 1, and further in view of Evans (US 3,792,863) as supported by Lagerblade (US 1,444,842). The Applicants respectfully request reconsideration in view of the Remarks below.

The Office Action asserts that:

Storek in view Petrash and in view of Evans significantly discloses the claimed invention as discussed above but fails to teach a ferrule that connects the head of the golf club to the shaft of the golf club. Nevertheless such modification is notoriously well known in the art. Storek in view of Petrash and in view of Evans discloses that parts of the golf club are used as an antenna. A ferrule of the golf club is considered as a part of the golf club. A ferrule is commonly used to connects the head of the golf club to the shaft of the golf club in order to secure the head of the golf club to the shaft of the golf club. Furthermore, the ferrule prevents the shaft from splitting. This is supported by Lagerblade (lines 102-108). Therefore it would have been obvious to modify Storek in view of Evans instrumented golf club, and incorporate Lagerblade's ferrule in order to prevent the shaft from splitting.

Applicants respectfully disagree that any art of record, whether individually or in combination, discloses the claimed subject matter. In fact, as characterized by the cited passage above, Lagerblade merely shows a ferrule that may be used to prevent a shaft from splitting. Applicants

do not dispute that Lagerblade discloses a ferrule for a golf club. Claim 6, however, does not merely recite a golf club having a ferrule. Rather, claim 6 recites “*an antenna that comprises a ferrule* that connects the head of the golf club to the shaft of the golf club.” (emphasis added). Neither Lagerblade nor any other art of record, however, actually teaches, discloses, or otherwise suggests an antenna that comprises a ferrule connecting the head of the club with the shaft.

For example, in an embodiment that incorporates the antenna within the ferrule, a different head/shaft combination may be used without requiring rewiring or attachment of an antenna within a new shaft. Applicants respectfully submit that the subject matter recited in dependent claim 6 is drastically different that utilizing only the shaft as an antenna as disclosed in the art of record.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection in respect to claim 6.


CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated: December 8, 2008

By: _____


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